

BS
47. (Amended) The method of claim 9 wherein the electronic legal documents include at least one of electronic calendar data, graphics, text, email attachment, and a file type identified by a file extension.

B9
49. (Amended) The machine-readable medium of claim 28 wherein the electronic legal documents include at least one of electronic calendar data, graphics, text, email attachment, and a file type identified by a file extension.

REMARKS

This amendment is being filed along with a request for continued examination (RCE) application in response to the final Office Action having a mailing date of October 22, 2002, and in response to the Advisory Action having a mailing date of January 17, 2003. Claims 1, 4-14, 17-21, 23, 28-30, 33, 43, 47, and 49 are amended as shown. More specifically, the independent claims are amended to more clearly recite what is being claimed and to recite further distinctive features. No new matter has been added. With this amendment, claims 1-49 remain pending in the application.

In the final Office Action having a mailing date of October 22, 2002, claims 1-49 were rejected under 35 U.S.C. § 112, first paragraph. More specifically, the Examiner stated that the applicants' original specification failed to disclose the "third-party electronic files." Furthermore, the Examiner stated that the use of the term "electronic files" in the amended claims enlarged the scope of the invention, without the requisite disclosure of the supporting technique as how to converge different formats of "electronic files" into electronic legal documents for processing. Claims 1-49 were rejected under 35 U.S.C. § 102(e) as being anticipated by Beck (U.S. Patent No. 6,332,154).

In the applicants' response (mailed on December 23, 2002) to the final Office Action, the applicants argued that the specification does include sufficient written description and disclosure for third-party electronic files. The applicants also argued that the claims in their

amended form do distinguish over Beck, since Beck discloses a system where communications between the various customers need to be performed through the Beck system.

In the January 17, 2003 Advisory Action, the Examiner maintained the rejection under 35 U.S.C. § 112, first paragraph, stating that the specification does not disclose "the technique to integrate all of the possible tools or packages for storing and indexing the claimed electronic files." Moreover, the Examiner maintained the rejection on the basis of Beck, by referencing Figure 15 of Beck where "instead of direct interaction between each other, customer 305, is obviously communicates with Venders 1-3 (another type of customer of Beck's system) via a third party (for example, Agents 1-3) using the agent collaboration module as disclosed in the same Figure by Beck." In view of the new amendments submitted herewith and in view of the accompanying remarks, the applicants respectfully request that the Examiner withdraw the rejections and allow the pending claims.

A. The 35 U.S.C. § 112, First Paragraph Rejection

The Examiner has taken the position that the applicants have failed to meet the requirements of 35 U.S.C. § 112, first paragraph, because the specification allegedly fails to disclose the technique to integrate "all of the possible tools" or packages for storing and indexing the claimed electronic files. The applicants respectfully disagree with this position. The written description requirement of 35 U.S.C. § 112, first paragraph, requires that the applicants provide written description of at least one embodiment of the invention. This statute does not require the applicants to disclose every possible embodiment that may have been developed or that may be developed in the future. Indeed, it is often difficult, if not impossible, for an inventor to foresee all of the possible embodiments that may currently exist or be developed. In the instant application, the applicants have provided written description of at least one embodiment for integrating a tool to process electronic files. For example, page 19, lines 1-5 of the present application describes how the converter 328 can use multiple versions of most application programs to read and translate files. As a person skilled in the art having the benefit of this disclosure would appreciate, one of these application programs that may be used by the converter 328 can be WordPerfect 5.0, for example, to open and read corresponding WordPerfect or other

applicable electronic files. The present application contains numerous other sections where techniques to process electronic files are described.

However, in the interest of facilitating prosecution, the various claims have been amended as shown. In particular on page 2 of the Advisory Action, the Examiner pointed out some language that can be added to the claims to address the 35 U.S.C. § 112, first paragraph rejection. The applicants thank the Examiner for this helpful suggestion. Accordingly, independent claims 1, 13, 20, 23, and 43 are amended to recite that the electronic files “can be subject to a legal proceeding.” With these amendments, these claims are now further allowable over 35 U.S.C. § 112, first paragraph. Independent claims 9 and 28 are amended to recite electronic legal documents, and independent claim 17 is amended to recite electronic documents. The terms “electronic legal documents” and/or “electronic documents” in these claims are consistent with the definition provided in the applicants’ specification. Moreover, this terminology was previously accepted by the Examiner in the first Office Action of March 7, 2002 (which did not provide a 35 U.S.C. § 112, first paragraph rejection). Accordingly, claims 9, 17, and 28 are now also further allowable over 35 U.S.C. § 112, first paragraph.

The various dependent claims, which depend upon the various independent claims, are amended to make their language consistent with the newly amended independent claims. Independent claims 1 and 28 and some of their dependent claims are further amended to recite --storage system-- instead of “database system.” This amendment clarifies that the claimed storage system need not necessarily have a database format. Dependent claims 47 and 49 are amended to provide examples of electronic legal documents.

B. The 35 U.S.C. § 102(e) Rejection Under Beck

Beck discloses a type of customer relationship management (CRM) system. The system of Beck is intended to be installed in a business, for example, to allow the business’ customers to better interact with agents or other representatives of the company. The customers use the Beck system to place orders, request customer service, or to communicate with vendors. As shown in Figure 2 of Beck (and also in Figure Y of the applicants’ amendment filed on July 29, 2002), customers A and B communicate with agents A and B via the Beck system. Customers A and B do not communicate with each other. The Examiner has referenced Figure

15 of Beck to illustrate communication of the customer 305 with vendors 1-3, via the agents 1-3 and the agent collaboration module 307. It is important to note that in these two examples of Figures 2 and 15, any communications between the different customers or vendors need to be performed through the Beck system. The communication through interfaces in the Beck system is a necessity in Beck, because Beck needs to identify the specific customers and what type of service they seek.

As described in Beck on column 40, lines 21-67 through column 41, lines 1-54, Figure 15 of Beck relates to a diverse interaction model (DIM) 301 that can interface with a customer-interaction network operating system (CINOS). The DIM 301 is a programmable interface that allows the customer 305 to communicate with agents 1-3 who are part of the DIM 301. A data repository 303 is provided to store the communications dialogue between the customer 305 and agents 1-3. See *e.g.*, column 41, lines 9-23 of Beck. The agent collaboration module 307 is provided to facilitate multimedia chats or other types of communications between the customer 305 and the agents 1-3. See, *e.g.*, column 41, lines 47-54 of Beck. Agents 1-3 obtain required information from vendors 1-3 as they collaborate and share information via in-place discussion through the interactive function module 307. See, *e.g.*, column 42, lines 3-5 of Beck. Therefore, it is clear from this and other sections of Beck that the communications between the various parties are performed through one or more components of the Beck system, so that the Beck system can properly track and process the communications as they are occurring.

Independent claim 17 has been amended to recite that the server comprises part of a network portion. Support for this amendment can be found, for instance, in Figure 1 of the present application, where the server 112 is shown as belonging to part of a network 110. Page 8, lines 6-8 of the present application, further indicate that the network 110 that includes the server 112 can comprise a portion of a network.

Claim 17 is further amended to recite that the electronic documents were previously communicated between parties independently of and externally to the network portion having the server. Support for this amendment can also be found, *inter alia*, in Figure 1 of the present application (showing the information system 130 that is the source of electronic documents as being independent of and external to the server 112), and on page 11, lines 15-19

and on page 16, lines 5-11 (describing one form of the electronic legal documents from the information system 130 as emails). As described throughout the applicants' specification, the emails that are subject to a legal process, such as discovery, can include emails that were previously exchanged between certain parties, and which now need to be reviewed by legal professionals. Figure 4 of the present application shows an example of an email that was previously communicated between two parties and is now under the subject of examination. Moreover, it is clear from these example descriptions in the application that the various electronic documents were communicated between parties in a manner that was independent of a network portion having the server 112. The electronic documents were communicated using any suitable communication medium, and does not involve the server 112, since the server 112 is used only in connection with subsequent processing of the legal documents after they have been communicated and uploaded to the database system 120 of Figure 1.

These new amendments to claim 17 distinguish over Beck. As shown in Figure 15 of Beck and described above and in the Beck patent itself, the Beck system requires the customer 305 to communicate with vendors 1-3 via the agent collaboration module 307. Such communications do not occur externally to and independent of the server or other component in the network of Beck--the DIM 301 of Figure 15 of Beck, through which communications occur, comprises part of the CINOS server 77 or other portion of the CINOS system of Beck. Furthermore, the Examiner has also acknowledged that the communication of Beck is performed using the agent collaboration module 307 of Beck. See, *e.g.*, page 3, last paragraph, of the Advisory Action. The fact that Beck requires communication to occur within its system is highlighted on column 41, lines 55-61, of Beck, where it is stated that "agent 1 may be conversing with customer 305 via COST phone, while engaged with vendor 1 via DNT phone such that the DNT conversation is not audible to customer 305." This description makes it clear that any sort of communication between the customer 305 and the vendor 1 needs to use the agent 1 of the Beck system as a "go-between." This is not external or independent communications of electronic documents as recited in claim 17. Therefore, amended claim 17 is further allowable over Beck under 35 U.S.C. § 102(e).

Amended independent claim 1 recites that the electronic files were previously communicated independently of and externally to a network portion having the server. As

described above, this is not disclosed, taught, or suggested by Beck, and therefore amended claim 1 is further allowable over Beck. Dependent claim 4 has been amended to recite the distinctive element of electronic files that have been previously exchanged between parties, independently of and externally to the network portion having the server.

Independent claim 9 recites that the electronic legal documents have been previously communicated between parties independently of and externally to an interface that provides the first field. As described at column 40, lines 25-28 of Beck, the DIM 301 includes an interface, and requires that the communications between parties be performed through that interface. Since independent claim 9, as amended, recites that the communication is independent of and external to an interface, claim 9 allowable over Beck.

Independent claim 13 is amended to recite electronic files that were previously communicated between parties independently of and externally to a network portion that performs the extracting of the electronic files. Again, this is a feature that is not disclosed, taught, or suggested by Beck because all of the communication of Beck is performed through its system. Independent claim 13 is thus further allowable over Beck.

Independent claim 20 is amended to recite that the electronic files were previously communicated between parties independently of and externally to the network portion having the server. Amended independent claim 23 recites that the previously communicated electronic files were communicated independently of and externally to a network portion having the data structure. Amended independent claim 28 recites that the electronic legal documents were previously communicated independently of and externally to a network portion having the storage system. Independent claim 43 is amended to recite that the electronic files were previously communicated independently of and externally to a network portion that includes the recursive engine. These are features that are not found in Beck, since Beck integrates all communications within its system as they are performed, and therefore, these claims are allowable.

The various claims as amended recite the communication of the electronic files and/or electronic documents. It is appreciated that these communications can involve the two-way communication between parties (*e.g.*, human individuals) such as via email. It is also appreciated that this exchange of communication can also involve "one-way" communications

between parties, such as a user's saving data to a file system or to an electronic calendar or other data repository.

The appropriate extension of time and fee is included along with this amendment. It is believed that the formal drawings submitted on December 23, 2002, along with the response to the final Office Action, have been entered and accepted, despite the fact that the arguments submitted in that response were deemed unpersuasive by the Examiner.

Overall, none of the references singly or in any motivated combination disclose, teach, or suggest what is recited in the independent claims. Thus, given the above amendments and accompanying remarks, the independent claims are now in condition for allowance. The dependent claims that depend directly or indirectly on these independent claims are likewise allowable based on at least the same reasons and based on the recitations contained in each dependent claim.

If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to the allowability of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 622-4900.

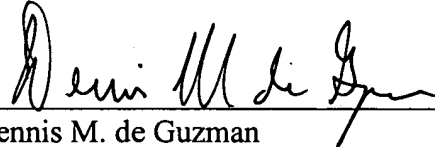
The Commissioner is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment to our Deposit Account No. 19-1090. Attached hereto is a marked-up version of the changes made to the claims by the current Amendment. The attached page is captioned **"Version With Markings to Show Changes Made."**

All of the claims remaining in the application are now clearly allowable.
Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

Michael C. Weaver et al.

SEED Intellectual Property Law Group PLLC



Dennis M. de Guzman
Registration No. 41,702

DMD:dma

Enclosures:

Postcard

Petition for 2-month extension (and fee)

701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092
Phone: (206) 622-4900 -310
Fax: (206) 682-6031

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Claims 1, 4-14, 17-21, 23, 28-30, 33, 43, 47, and 49 have been amended.

1. (Twice Amended) A method, comprising:

storing ~~third-party~~ electronic files, which can be subject to a legal proceeding, in a database-storage system, including storing and indexing electronic characteristics associated with a native format of the electronic files;

providing access to the stored electronic files to a user terminal via a server communicatively coupled to the ~~database-storage~~ system and to the user terminal, the electronic files being previously communicated independently of and externally to a network portion having the server; and

if user-input information sent from the user terminal to the server is received, processing the indexed electronic files according to the received user-input information in a manner that allows the processing to use the stored electronic characteristics of the electronic files.

4. (Twice Amended) The method of claim 1 wherein storing the ~~third-party~~ electronic files in the ~~database-storage~~ system, including storing and indexing the electronic characteristics associated with the native format of the electronic files comprises:

recursively extracting a plurality of ~~third-party~~ electronic files that have been previously exchanged, between parties, independently of and externally to the network portion having the server;

identifying a plurality of objects having different data formats for each of the extracted electronic files, one of the identified objects corresponding to the electronic characteristics;

storing data associated with the one of the identified objects in a first location in the ~~database-storage~~ system;

converting the other identified objects and storing data associated with the converted objects in a second location in the ~~database-storage~~ system; and
indexing the data stored in the first and second locations.

5. (Twice Amended) The method of claim 1 wherein storing the ~~third-party~~ electronic files comprises:

storing data associated with text content of the electronic files in a first server unit; and

storing data associated with metadata content of the electronic files in a second server unit having a database.

6. (Twice Amended) The method of claim 1, further comprising providing a user interface at the user terminal, the user interface comprising a field to enter search query information and a display to display processing summary information associated with the electronic files stored in the ~~database-storage~~ system.

7. (Twice Amended) The method of claim 1 wherein processing the indexed electronic files comprises:

selecting one of the stored electronic files based on the user-input information

transmitting a copy of the selected electronic file for display at the user terminal;

receiving from the user terminal processing summary information associated with the displayed electronic file; and

storing the processing summary information in the ~~database-storage~~ system to allow the processing information and their corresponding electronic file to be subsequently retrieved.

8. (Twice Amended) The method of claim 1 wherein the electronic files comprise email messages having attachment files, the method further comprising:

separating the attachment files from the email messages;

converting the attachment files into a first format and storing the converted attachment files in the ~~database-storage~~ system; and

converting the email messages into a second format and storing the converted email messages in the ~~database-storage~~ system.

9. (Twice Amended) A method to display stored electronic ~~files~~ legal documents, the method comprising:

providing a first field to allow ~~a user to enter entry of~~ search query information directed towards the stored electronic ~~files~~ legal documents, wherein the electronic ~~files~~ legal documents ~~comprise third-party electronic files documents that have been previously communicated between parties independently of and externally to an interface that provides the first field;~~

providing a window to display a representation of an electronic ~~file~~ legal document retrieved in response to the entered search query information, the electronic ~~file~~ legal document being retrievable by matching the search query information with stored electronic characteristics associated with a native format of the electronic ~~files~~ legal documents; and

providing a plurality of second fields to allow ~~the user to enter entry of~~ and to save processing information associated with the displayed representation of the electronic ~~file~~ legal document.

10. (Twice Amended) The method of claim 9 wherein the electronic ~~files~~ legal documents ~~comprise email messages having threading information and wherein matching the search query information with the stored electronic characteristics comprises providing search results including threading information of email messages.~~

11. (Twice Amended) The method of claim 9, further comprising:

providing summary fields having summary information associated with the stored electronic ~~files~~ legal documents; and

providing the summary fields with links that, if activated, trigger a display of representations of electronic ~~files~~ legal documents corresponding to the activated links.

12. (Twice Amended) The method of claim 9, further comprising:
providing search result fields having search result information associated with the search query information; and

providing the search result fields with links that, if activated, trigger a display of representations of electronic files legal documents corresponding to the activated links.

13. (Twice Amended) A method, comprising:
recursively extracting a plurality of ~~third-party~~ electronic files that can be subject to a legal proceeding, each of the electronic files having electronic characteristics that are associated with a native format of the electronic file and that uniquely identify the electronic files from each other, the electronic files being previously communicated between parties independently of and externally to a network portion that performs the extracting;

for each of the extracted electronic files, identifying a plurality of objects having different data formats, one of the identified objects corresponding to the electronic characteristics;

storing data associated with the one of the identified objects in a first location in a database system;

converting the other identified objects and storing data associated with the converted objects in a second location in the database system; and

indexing the data stored in the first and second locations.

14. (Twice Amended) The method of claim 13 wherein recursively extracting the plurality of ~~third-party~~ electronic files comprises extracting ~~third-party~~ electronic files located in a plurality of paths in a directory structure.

17. (Twice Amended) ~~A network node~~ An apparatus, comprising:
a server comprising part of a network portion and being communicatively coupled to a database system, the database system having stored and indexed therein ~~third-party~~ electronic files documents and electronic characteristics associated with a native format of the electronic files documents, the electronic documents being previously communicated between

parties independently of and externally to the network portion having the server, the server responsive to a search query to search the database system for electronic files documents matching the search query, the server being configured to use indexing information and the stored electronic characteristics to provide search results that are responsive to the search query.

18. (Twice Amended) The ~~network node apparatus~~ of claim 17 wherein the server stores user-input information associated with representations of electronic ~~files~~ documents, the user-input information being stored by the server in the database system and being retrievable by the server in response to subsequent search queries.

19. (Twice Amended) The ~~network node apparatus~~ of claim 17 wherein the electronic ~~files~~ documents comprise email messages having threading information, the electronic characteristics of the electronic ~~files~~ documents including the threading information, the server being configured to provide the search results to the user node along with email messages and their corresponding threading information.

20. (Twice Amended) A system, comprising:
a conversion engine to convert ~~third-party~~ electronic files, which can be subject to a legal proceeding, into a database format, the conversion engine being configured to identify electronic characteristics associated with a native format of the electronic files; and

a network portion having a server coupleable to the conversion engine and communicatively coupled to a database system, the database system having stored and indexed therein the ~~third-party~~ electronic files converted by the conversion engine and the electronic characteristics identified by the conversion engine, the electronic files being previously communicated between parties independently of and externally to the network portion, wherein the server is responsive to a search query to search the database system for electronic files matching the search query, wherein the server is configured to use the indexing information and the electronic characteristics to provide search results that are responsive to the search query.

21. (Twice Amended) The system of claim 20 wherein the conversion engine is structured to load the electronic files into the database system, the conversion engine including:

at least one recursive engine to recursively extract a plurality of ~~third-party~~ electronic files that can be subject to a legal proceeding;

at least one controller coupled to the recursive engine to identify a plurality of objects having different data formats for each of the extracted electronic files, one of the identified objects corresponding to the electronic characteristics;

an upload unit coupled to the controller to store data associated with the one of the identified objects in a first location in the database system; and

at least one converter coupled to the controller to convert the other identified objects and to store text data associated with the converted objects in a second location in the database system, wherein

the data stored in the first and second locations are indexed.

23. (Twice Amended) A machine-readable medium containing a data structure of ~~third-party~~ electronic file information comprising a plurality of first tables having indexing information associated with a text content of ~~third-party~~ electronic files that can be subject to a legal proceeding, a second plurality of tables having indexing information associated with metadata content of the electronic files, the indexing information in the second tables corresponding to electronic characteristics associated with a native format of the electronic files, the electronic files being previously communicated between parties independently of and externally to a network portion having the data structure.

28. (Twice Amended) A machine-readable medium having stored therein instructions, which when executed by a processor, cause the processor to perform the following, comprising:

provide access to ~~third-party~~ electronic files legal documents stored in a database storage system, the electronic legal documents being previously communicated independently of and externally to a network portion having the storage system, the stored electronic files legal

documents being stored and indexed in the ~~database-storage~~ system along with electronic characteristics associated with the native format of the electronic ~~files~~ legal documents; and

if user-input information is received, process the indexed ~~third-party~~ electronic ~~files-legal documents~~ according to the received user-input information and by using the stored electronic characteristics.

29. (Twice Amended) The machine-readable medium of claim 28 wherein the processor further performs the following, comprising:

if user-input information including a text content search query is received, search the stored electronic ~~files-legal documents~~ using indexing information associated with textual content of the stored electronic ~~files~~ legal documents; and

if user-input information including a metadata search query is received, search the stored electronic ~~files-legal documents~~ using indexing information associated with metadata content of the stored electronic ~~files~~ legal documents.

30. (Twice Amended) The machine-readable medium of claim 28 wherein the stored electronic ~~files-legal documents~~ comprise email messages and wherein the processor searches for individual email messages based on user-input information including a search query of metadata content or text content of the email messages.

33. (Twice Amended) The ~~network-node-apparatus~~ of claim 17 wherein the electronic ~~files-documents~~ comprise electronic legal documents.

43. (New Amended) An apparatus, comprising:

at least one recursive engine to recursively extract a plurality of ~~third-party~~ electronic files that can be subject to legal proceeding, each of the electronic files having electronic characteristics that are associated with a native format of the electronic files and that uniquely identify the electronic files from each other, the electronic files being previously communicated independently of and externally to a network portion that includes the recursive engine;

at least one controller coupled to the recursive engine to identify, for each of the extracted files, a plurality of objects having different data formats, one of the identified objects corresponding to the electronic characteristics;

a first storage location coupled to the controller to store data associated with the one of the identified objects corresponding to the electronic characteristics;

at least one converter coupled to the controller to convert the other identified objects; and

a second storage location coupled to the converter to store text data associated with the converted objects, wherein the data stored in the first and second storage locations are indexed.

47. (NewAmended) The method of claim 9 wherein the ~~electronic files~~ comprise electronic legal documents include at least one of electronic calendar data, graphics, text, email attachment, and a file type identified by a file extension.

49. (NewAmended) The machine-readable medium of claim 28 wherein the ~~electronic files comprise electronic legal documents~~ include at least one of electronic calendar data, graphics, text, email attachment, and a file type identified by a file extension.